REMARKS

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 1-27 are presently active in this case. Claims 28-37 were withdrawn. In the present request for reconsideration, none of the claims are amended.

The outstanding Office Action withdrew Claims 28-37 from consideration as being drawn to a non-elected group that was elected by original presentation under M.P.E.P. § 821.03. Claims 1-27 were rejoined, and Claims 10-23 were held rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Claims 3, 9, 11-23 and 25-27 were rejected under 35 U.S.C. § 112, second paragraph, as indefinite. Claims 1-17, 22-24, and 26 were rejected under 35 U.S.C. § 102(b) as being anticipated by Mitani et al. (U.S. Patent No. 6,052,200, hereinafter "Mitani"). Claims 18-21, 25 and 27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Mitani and further in view of Shimizu et al. (U.S. Patent No. 6,052,202, hereinafter "Shimizu").

First, Applicants' representative Nikolaus P. Schibli wants to thank Examiner Zheng for the telephone discussion regarding the withdrawal of Claims 28-37 from consideration. Applicants herewith provide the formal response to traverse the restriction requirement as discussed during the telephone interview.

Applicants respectfully request rejoinder of Claims 28-37, examination of these claims on the merits, and cancellation of Claims 1-27, because independent Claim 28 (directed to a image forming apparatus) and independent Claim 34 (directed to a method of acquiring a memory area) are not outside the scope of the inventions that were constructively elected by first presentation by original Claims 1-27, as next discussed.

M.P.E.P. § 821.03 provides that when "applicants has received an action on the merits for the originally presented invention, this invention has been constructively elected by

original presentation." In addition, "[a]n amendment canceling all claims ***drawn to the elected invention*** and presenting ***only claims drawn to the nonelected invention*** should not be entered." (Id., emphasis added.)

But Applicants respectfully submit that newly presented independent Claim 28 is not directed to a non-elected invention, but is directed ***to the same invention*** that was elected by original presentation with original Claim 1. Both claims are directed to the embodiment shown in Applicants' Fig. 1, and are directed to an image forming apparatus. In addition, both claims include three apparatus elements, being a image data conversion part, a resource management part, and a image data management part in original Claim 1, and an image conversion unit, resource management unit, and an image data management unit as in newly presented Claim 28. In this respect, Applicants' Fig. 1 shows by means of a non-limiting example a Media Link Board 45 (MLB), system resource manager 21 (SRM), and Image Handler 23 (IMH), and as explained in a non-limiting description on p. 22 ll. 22-24 of Applicants' specification, the MLB 45 is a hardware item to convert a format of image data into another format.

Although new Claim 28 recites additional features and is written in language that better complies with U.S. claim drafting form, Claim 28 rests within the scope of the invention that was elected by original presentation by original Claim 1, as represented in Applicants' Fig. 1. In addition, the rejections under 35 U.S.C. § 112, first and second paragraph, required amendments of form.

If every presentation of new claims directed to the same invention would result in a deliberate withdrawal of the newly presented claims by the U.S.P.T.O., it would not be possible to present any new claims to better comply with U.S. claim drafting practice to correct formal issues after a non-final Office Action, without having to refile the new claims as a new divisional application. Such withdrawal of the claims is not condoned by the

provisions of the M.P.E.P., and would substantially burden Applicants with increased expenses for the prosecution of their claims on the merits.

The same rationale is applicable for Applicants' new independent Claim 34. Claim 34 is directed to a method of acquiring a memory area, and is directed to the embodiment shown with respect of Applicants' Fig. 5. Claim 34 has three different method steps. At the same time, original independent Claim 24 is also directed to a method of acquiring a memory area with three different method steps, and directed to the invention as represented by Fig. 5.

In light of the above discussion, Applicants traverse the withdrawal of Claims 28-37 as being directed to a non-elected invention, because the claims are not outside of the scope of the inventions that were constructively elected by original presentation.

Accordingly, Applicants respectfully request rejoinder of Claims 28-37 for the examination of the claims on the merits.

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